



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,350	09/18/2000	Avi Ashkenazi	10466/14	8200

28442 7590 12/17/2001

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 12/17/2001

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,350

Applicant(s)

ASHKENAZI ET AL.

Examiner

Channing S Mahatan

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 39-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Art Unit: 1631

DETAILED ACTION

ART UNIT DESIGNATION

The Group and/or Art Unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence regarding this application should be directed to Group Art Unit 1631.

Election/Restrictions

Applicant is required to elect one (1) specie from the two (2) specie election requirements.

FIRST SPECIE ELECTION REQUIREMENT

- A. isolated non-chimeric polypeptides of claims 39-49
- B. chimeric polypeptides of claims 39-51

This application contains claims directed to the following patentably distinct species of the claimed invention:

A. The isolated non-chimeric polypeptides are composed of any of the 20 naturally occurring amino acids that having the basic formula $\text{NH}_2\text{CHR}\text{COOH}$. B. The chimeric polypeptides are made by the fusion of a polypeptide to a heterologous polypeptide which is further limited to an epitope tag or an Fc region of an immunoglobulin. The above species would have differing utilities, particular to detection methods. It is acknowledged that various processing steps may cause a chimeric polypeptide of Group B to be directed as to its synthesis by a polypeptide of Group A, however, the differing compositions of matter having differing biological, biochemical, and physical properties of the inventions of the isolated non-chimeric polypeptides, and chimeric polypeptides supports the undue search burden if both were examined together. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species

Art Unit: 1631

for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 39-49 are generic.

SECOND SPECIE ELECTION REQUIREMENT

This application contains claims directed to the following patentably distinct species of the claimed invention:

- A. Polypeptide/polypeptide deposited under American Type Culture Collection accession number 209375 (SEQ ID 23), claims 39-45, 47, and 49-51
- B. Polypeptide (SEQ ID 23) lacking its associated signal peptide, claims 39-44, 46-48, 50, and 51.
- C. Extracellular domain of the polypeptide (SEQ ID 23) with its asserted signal peptide, claims 39-44, 47, 50, and 51.
- D. Extracellular domain of the polypeptide (SEQ ID 23) lacking its associated signal peptide, claims 39-44, 47, 48, 50, and 51

A. Amino acid sequence as disclosed by SEQ ID 23. B. Amino acid sequence, as disclosed by SEQ ID 23, lacking its associated signal peptide (residues 1-22). C. The amino acid sequence of the extracellular domain as disclosed by SEQ ID 23. D. The amino acid sequence of the extracellular domain, as disclosed by SEQ ID 23, lacking its associated signal peptide (residues 1-22). It is acknowledged that the above species are derivatives, lacking amino acid sequence elements, of each other. However, the lack of such elements alters the polypeptide function/composition to the extent that the above species are considered distinct. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to

Art Unit: 1631

which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 39-44, 47, 50, and 51 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

INVENTORSHIP AMENDMENT

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

Art Unit: 1631

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

EXAMINER INFORMATION

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Channing S. Mahatan whose telephone number is (703) 308-2380. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Pauline Farrier, whose telephone number is (703) 305-3550 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Date:

December 13, 2001

Examiner Initials:

CSM

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER